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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,769	03/09/2006	Makoto Numakawa	07A3825PCT	3001
7590 Quinn Emanuel Urquhart Oliver & Hedges, LLP Koda/Androlia 10th Floor 865 S. Figueroa Street Los Angeles, CA 90007			EXAMINER EIDE, HEIDI MARIE	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 03/16/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,769

Applicant(s)

NUMAKAWA ET AL.

Examiner

HEIDI M. EIDE

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 12 the recitation of positively claiming the handpiece is inconsistent with the preamble. The applicant should clarify what subject matter the claim is drawn to, i.e. either the subcombination of the maintenance apparatus alone or the combination of the maintenance apparatus and the handpiece.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown 5,520,882.

Brown teaches a maintenance apparatus 30 for a medical handpiece 10 with a chucking structure for detachably chucking a holding rotary tool along an axis and a bearing for rotatably supporting the chucking structure along the axis (col. 3, ll. 20-23, col. 5, ll. 13-17) comprising a maintenance fluid supply nozzle fluidly connected to a

second fluid supply, the design of the nozzle is capable of being detachable connected in the chucking structure in place of the rotary tool so that the maintenance fluid is fed through the nozzle into the chucking structure as illustrated in fig. 4. Brown does not specifically teach the device functioning as claimed, however, the nozzle connected to the fluid supply 30 is capable of being detachable connected to the chucking structure therefore the claimed limitations are met. Brown further teaches a first fluid supply 20 for feeding the maintenance fluid to the bearing of the handpiece as illustrated in fig. 2 (see abstract) and wherein the nozzle comprises an elongated nozzle having an outer diameter that is capable of being substantially equal to an outer diameter of a rotary tool and the elongated nozzle having one end portion capable of insertion into a chucking structure and another end portion being coupled to the second fluid supply.

Claims 9-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman 5,165,503.

Hoffman teaches a maintenance apparatus comprising a maintenance fluid supply nozzle 248 capable of being fluidly connected to a second fluid supply, the supply nozzle being capable of being detachably connect in a chucking structure in place of a rotary tool so that a maintenance fluid is fed through the nozzle into the chucking structure. Hoffman further teaches a first fluid supply capable of feeding the maintenance fluid to a bearing of a handpiece (col. 6, ll. 17-21), a connector 52 which is designed to be detachable connect to a handpiece (fig. 2), the connector having a feeding passage 42 of the first fluid supply capable of feeding the maintenance fluid

through the first feeding passage to a bearing of a handpiece and a feeding passage 55 of the second fluid supply capable of feeding the maintenance fluid through the nozzle of a chucking structure, wherein the connector has a recycling passage 56 which is capable of being detachably connected to a feeding passage of a handpiece and a handpiece having a recycling passage 18 which is capable of being detachably connected to the first feeding passage (col. 6, ll. 17-21, ll. 28-30), wherein when a handpiece is connected to the connector a maintenance fluid can be fed through the feeding passages of the connector and a handpiece to a bearing of a handpiece and then collected together with the maintenance fluid fed through the supply nozzle through the recycling passages of the connector and a handpiece. Hoffman further teaches the maintenance fluid supply nozzle comprising an elongated nozzle capable of having an outer diameter substantially equal to an outer diameter of a rotary tool, the elongated nozzle having an end portion capable for insertion into a chucking and another end portion capable of being coupled to a second fluid supply. Huffman does not specifically teach the apparatus functioning as claimed, however, the apparatus is capable of functioning as claimed; therefore the claimed limitations are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman 5,165,503 as applied to claims 9-12 above, and further in view of De Rocchis et al. 4,990,087 (De Rocchis).

Hoffman teaches the invention as substantially claimed and discussed above, however, does not specifically teach the nozzle having a hole for injecting the maintenance fluid in the form of a mist.

De Rocchis teaches the nozzle having a hole for injecting the maintenance fluid in the form of a mist (col. 3, ll. 38-41). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Hoffman with the nozzle of De Rocchis in order to cover a larger area of the apparatus with the maintenance fluid and to conserve the fluid.

Response to Arguments

Applicant's arguments filed June 29, 2009 have been fully considered but they are not persuasive.

In response to applicant's argument that Brown does not teach the nozzle being detachably connected to the chucking structure, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is well known in the art that the handpiece taught by Brown holds the bur (col. 3, l. 24) and that the bur can be removed from the handpiece. While Brown shows the

handpiece with the bur located in the chuck, the bur is capable for being removed from the chuck. Since the bur is capable of being removed from the chuck, once the bur is removed, the nozzle is capable of being inserted in the chuck in the same hole that the bur occupied. While the prior art does not teach the device functioning as claimed, that applicants arguments are not persuasive because the apparatus is capable of functioning as claimed (described above) and therefore the claim limitations are met.

In response to applicant's argument directed to Hoffman, applicant argues that the rotary tool is provided in the chuck; however, as discussed above, the tool is capable of being removed from the handpiece, which would allow for the nozzle to be inserted in the tools spot. Applicant further argues that the tube could not be detachable connected to the chucking structure, however, as taught in col. 7, ll. 36-40 if Hoffman the nozzle is removable from the apparatus. Since that nozzle is removable, it is capable of being inserted into the hole that the tool once occupied. As discussed above, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant further argues that the prior art of De Rocchis dose not teach the nozzle to be inserted into the chucking structure, however, De Rocchis is not used to teach this limitation, therefore this argument is moot.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **HEIDI M. EIDE** whose telephone number is (571)270-3081. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heidi Eide
Examiner
Art Unit 3732

/Heidi M Eide/
Examiner, Art Unit 3732

3/12/2010

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732